



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,409	10/17/2000	Hans-Peter Wild	357153/0004	3320
26610 7590 11/14/2007 STROOCK & STROOCK & LAVAN LLP 180 MAIDEN LANE NEW YORK, NY 10038			EXAMINER TRUONG, THANH K	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 11/14/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/690,409

Applicant(s)

WILD ET AL.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14 is/are rejected.
- 7) ☒ Claim(s) 8 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's RCE received on October 31, 2007.
2. Applicant's cancellation of claims 1-6 is acknowledged.
3. Claims 8 and 10 are objected to because of the following reason: the subject matter claimed in claims 8 and 10 is directed to the method of making a bag, and it is out side of the scope of the present claimed invention, which is the method of applying drinking straw to a bag. Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-10 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 7, 9, 10, 12, 15 and 17 of U.S. Patent No.

Art Unit: 3721

6,681,547 in view of Geyssel (4,584,046). Although the conflicting claims are not identical, they are not patentably distinct from each other, and the additional limitations that are added to the claims in the present application can be rejected in view of the Geyssel reference (4,584,046). In this instance case, Geyssel discloses and suggests, among other things, the method steps of: providing a plurality of straws above the conveyor belt, providing straws at an acute angle the conveyor belt or providing straws substantially parallel to a side wall of the bag.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the U.S. Patent No. 6,681,547 by incorporating the method as taught by Geyssel to provide a more effective method of applying drinking straws onto the stand up bag.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 10 as recited are vague and indefinite, because the claimed subject matter of claims 8 and 10 as recited is outside of the scope of the claimed invention – the present claimed invention is directed to the method of applying drinking straw to a bag, and wherein claims 8 and 10 are directed to the method of making a bag.

Accordingly, claims 8 and 10 are not being examined in this office action due to the indefiniteness. Claims 8 and 10 will be examined on their merits when the indefiniteness is resolved.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 7, 9, 11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Geyssel (4,584,046).

Geyssel discloses (figures 1-10) an apparatus and a method comprising:

providing a plurality of standup bag 12;

positioning a bag on a conveyor belt (13) so that the second side wall is at an acute angle with the conveyor belt (figure 9);

applying a straw package (11) onto the second side wall an acute angle to the conveyor belt (figure 9).

providing a plurality of straw packages from above the conveyor belt (Fig. 1 of Geyssel clearly shows that the straw packages are located on a higher elevation than the conveyor belt with respect to the ground, which supports the entire apparatus);

providing a transfer drum (20) above the conveyor belt, the transfer drum being rotatable about an axis substantially parallel to the second side wall (Fig. 1 of Geyssel

Art Unit: 3721

clearly shows that the transfer drum is located on a higher elevation than the conveyor belt with respect to the ground, which supports the entire apparatus);

providing a lever having a depressing arm (41a) and a pivoting arm (49);

rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply a straw package onto the second side wall at an acute angle to the conveyor belt (figures 1 and 6 of Geyssel – column 4, lines 62-68 and column 5, lines 1-14);

Geyssel discloses, column 1, lines 43-47, that:

*"It is the task of this invention to create a system with which objects, in particular drinking straws, labels, or the like, can be attached to objects such as packages, bottles, **bags**, etc., these being moved past on a conveyor belt..."* (emphasis added),

and on column 1, lines 6-8, that:

*"This invention relates to a device for attaching articles such as labels, drinking straws or the like to packages, bottles or **other objects**"* (emphasis added),

and in the Abstract:

*"The applicator device (10) can be tilted about two perpendicular directions and can be secured in order that the drinking straws (11) can be secured in different directions and on **variously inclined surfaces** of the package (12)"* (emphasis added),

and on column 2, lines 19-31, that:

*"It is expedient that the applicator element can be tipped in several directions in order that the article that has been made ready can be applied in various positions and on variously configured objects as selected ... the applicator element and the drive system are installed together on a carrier that can be tilted about two perpendicular axes and which can be secured ... the applicator element **can be placed in any desired angular position** against the objects to which the articles are to be secured" (emphasis added).*

It is further construed that Geyssel clearly anticipates the apparatus and method steps in which: the bag (12) includes the bag as recited in the Applicant's present claimed invention, and the drinking straws can be applied to the bag (of any design configuration) at any desired angular position with respect to the conveyor surface.

9. Examiner's note: additionally, regarding claims 13 and 14, also refer to the Final Office Action mailed on April 23, 2003 for the rejection of the apparatus claims 1-6 (now have been canceled), which are believed to contain the same scope and invention as claims 13 and 14. If the Applicant to argue that the now cancelled claims 1-6 and the claims 13 and 14 are not contained the same scope and invention, the Applicant is advised to point out the differences, and if that is the case, a restriction will apply to claims 13 and 14 in the future office action.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Geyssel (4,584,046) in view of Wild (4,572,758).

As discussed above in paragraph 8 of this office action, Geyssel discloses the claimed invention, but it does not expressly disclose the step of applying an adhesive on

Art Unit: 3721

the straw package prior to applying the straw package onto the second side wall as recited in claim 12.

Wild discloses an apparatus and a method in which the adhesive strip (29) is applied on the straw package (12) prior to the step of applying the straw package onto the second side wall of the container (bag). Wild provides *"a process and apparatus for increasing the yield of straws affixed to beverage containers by providing an adhesive on the straw packages"* (Wild – column 2, lines 46-49).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Geyssel apparatus and method by incorporating the apparatus and method as taught by Wild to provide an more effective machine and method of attaching drinking straws onto containers.

Response to Arguments

12. Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive.

In response to the Applicant's argument that:

"Applicants respectfully submit that Geyssel fails to teach or disclose "providing a lever having a depressing arm and a pivoting arm" and "rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt" as recited in claims 7, 9, 11, 13 and 14. Rather, Geyssel is directed to a two-arm tilt lever that pivots about the joining portion of the two arms as a result of a spring urging the two-arm tilt lever to pivot. Neither arm of Geyssel is rotated in order to displace the depressing arm downward toward the conveyor belt. Another embodiment disclosed by Geyssel is directed to a lever that is moved toward and away from the containers in a lateral movement. Accordingly, the levers of Geyssel fail to teach or disclose the invention as claimed in claims 7, 9, 11, 13 and 14, but rather, teaches away from the invention."

this is not found persuasive for the following reason: as mentioned above, it is construed that Geyssel clearly discloses the steps of providing a lever having a depressing arm (41a) and a pivoting arm (49); and rotating the pivoting arm of the lever to displace the depressing arm downward toward the conveyor belt to apply a straw package onto the second side wall at an acute angle to the conveyor belt (figures 1 and 6 of Geyssel – column 4, lines 62-68 and column 5, lines 1-14);

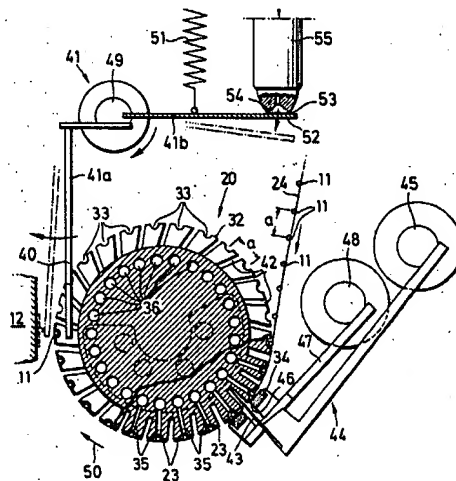
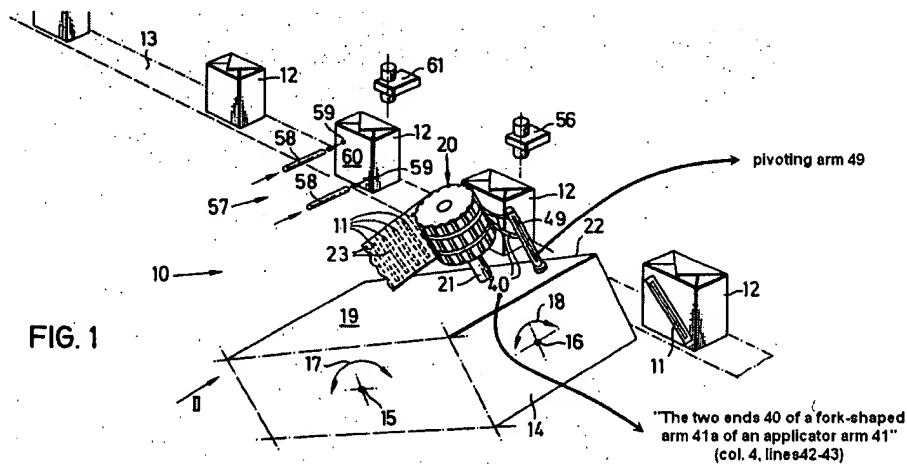


Fig. 6 – A plan view of the lever arm assembly

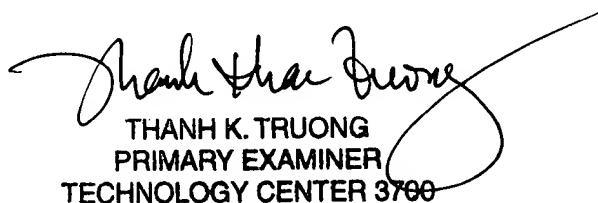
Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tkf
November 10, 2007.


THANH K. TRUONG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700